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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/615,780

07/10/2003

Noriyuki Nakanishi

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01/26/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

01/26/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/615,780	Applicant(s) NORIYUKI NAKANISHI	
	Examiner Lakshmi S. Channavajjala	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of response and amendment dated 10-1-08 is acknowledged.

The following rejection of record has been withdrawn in light of the amendment:

Claim Rejections - 35 USC § 112

1. Claims 5 and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Instant claims are indefinite with respect to the expression "passage of time" because it is unclear as to what is the length of time up to which t-butanol suppresses smell change or odor change at a concentration of 0.01 to 1000 ppm. Is it minutes, hours, day, months or years? A clarification is requested.

The following rejection of record has been maintained:

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Research Disclosure 2001 in view of any one of US 6190645 (US 645) or Industry Circular.

Research Disclosure 2001 teaches cosmetic compositions comprising surfactants such as oleath-20, laureth and SD Alcohol 40 (Aerosol mousse example on page 1842 and gel formulation example on page 1843), of which the surfactants read on the instant oxyethylene group containing surfactant and is also described in the

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instant example 5. The compositions of Research Disclosure do not state tert-butanol of instant claims.

However, US '645 states (col. 3, lines 47-54) that SD alcohol 40 is an ethyl alcohol that has been denatured with tert-butyl alcohol. Similarly, Industry Circular mentions different forms of SD alcohol 40, each of which is denatured with ethyl alcohol with a significant proportion of tert-butanol. Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made that the SD 40 alcohol of the cosmetic compositions of Research Disclosure contain t-butanol and even though the reference fails to teach the claimed method for suppressing smell change odor generation with passage of time in a cosmetic, it is implicit from the teachings of US 645 and Industry Circular that the SD 40 alcohol containing tert-butanol is effective in inhibiting the suppression of odor or smell change of oleath-20 or laureth surfactants of Research Disclosure. With respect to the amount of butanol, instant claims recite as low as 0.01 ppm. While the references fail to teach the amount of butanol, denaturing alcohol utilizes a significant portion of butanol (according to Industry Circular). Accordingly, the burden is shifted to applicants to show that 8% alcohol in the mousse or gel compositions do not suppress the smell or odor change caused by the surfactants.

Response to Arguments

Applicant's arguments filed 10-1-08 have been fully considered but they are not persuasive.

Applicants argue that the Research Disclosure merely lists a large number of exemplary compositions for various hair protection products and that among those, only two compositions include SD 40 alcohol with surfactants. Moreover, it provides the typical amounts of SD 40 alcohol in the range of *0% to 8%*, and some other compositions contain SD 40 alcohol despite the absence of any surfactants. This argument is not persuasive the prior art disclosure is not limited to specific embodiments and should be taken as a whole. It is admitted that the reference teaches 8% SD 40 alcohol.

1. It is argued that nowhere does Research Disclosure describe or suggest that some surfactants in the compositions may cause smell change or odor, nor does it states that SD 40 alcohol suppresses such smell change or odor. It is argued that considering the reference in its entirety, simply giving the range of *0% to 8%* of SD 40 alcohol, not tert-butanol, and having the majority of compositions with *no* SD 40 alcohol, Research Disclosure does not provide any inferences or suggestions of the desirability of doing what Applicant has done. However, while the examiner agreed that the reference fails to teach odor suppression, applicants have not shown that the SD40 of reference does not inhibit odor (see interview summary). It is argued that without addressing the smell change or odor generated by certain surfactants, no reasonable expectation of success can be found in Research Disclosure. Applicants argue the Industry disclosure and Sanoguiera et al references only show that SD40 alcohol contains t-butanol and not the method of odor suppression. However, examiner has cited the latter references to show that SD40 alcohol contains t-butanol. If t-butanol is capable of inhibiting odor then the same t-butanol in SD40 alcohol also should inhibit

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the odor suppression absent evidence to the contrary. Applicants have not provided any evidence that the SD40 alcohol does not contain the claimed amounts of t-butanol.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
January 21, 2009